

REMARKS/ARGUMENTS

Rejection of claim 34 under 35 USC §112 has been withdrawn in light of the amendment to claim 34.

The objection of claims 9-13 under 35 C.F.R.. §1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim was withdrawn in light of the amendment.

Claims 1, 14, 33, 34 and 35 have been amended and new claims 48 and 49 have been added. No new matter has been incorporated as a result of these claim amendments and additions.

Reconsideration of this Application in light of the Request for Continued Examination and Amendment is respectfully requested. This amendment addresses items brought up by the examiner in the final office action. In view of the amendments and following remarks, favorable consideration and allowance of the application is respectfully requested.

35 U.S.C. § 102 Rejections

Claim 1, 2, 5 and 23-26 remain rejected under 35 USC §102(b) as being anticipated by Pulfer *et al.* (Incorporation of Nitric Oxide-Releasing Crosslinked polyethyleneimine Microspheres Into Vascular Grafts; Journal of Biomedical Materials Research; Wiley, New York, NY, Vol. 37, No. 2, November 1997; pp 182-189).

Independent claim 1 has been amended to incorporate the limitation that the biocompatible polymer does not swell upon immersion in an aqueous solution. The polymer of the claimed invention do not swell upon immersion in aqueous solutions as is disclosed in paragraphs 0049 and 0050 of the instant specification.

The Pulfer *et al.* reference does not disclose a polymer which does not swell upon immersion in an aqueous solutions. In fact, Pulfer *et al.* specifically disclose that their polymer swell significantly. For example, on page 184, in the first paragraph after the Results heading, the Pulfer *et al.* reference states that “[w]hen immersed in PBS (pH 7.4, 10 mL), PEIX microspheres (200mg) swelled 70% with a high degree of initial volume

increase; the same amount of PEIX/NO microspheres swelled 100%, but with a much lower initial volume increase.”

In order to support an anticipation rejection under 35 U.S.C. §102(b), the Examiner must show that each and every element of the claimed invention is shown identically in a single reference. *In re Bond*, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990) citing *Diversitech Corp v. Century Steps, Inc.*, 7 U.S.P.Q.2d 1315, 1317 (Fed. Cir. 1988). The Pulfer *et al.* reference does not contain each and every element of the claimed invention as they presently appear.

The Pulfer *et al.* reference does not disclose the non-swelling characteristics of these highly cross-linked and extremely hydrophobic polymers as claimed in claims 1, 2, 5, 23-26 and new claims 48 and 49. Therefore, the invention as presently claimed is novel and inventive over the prior art of record and Applicants respectfully request that the present rejection of claims 1, 2, 5 and 23-26 be withdrawn.

35 U.S.C. §103 Rejections

Claims 3, 4, 6-22 and 33-47 remain rejected under 35 U.S.C. §103(a) as being unpatentable over Pulfer *et al.*

Applicant has amended claims 1, 14 and 33-35 to incorporate the limitation that the biocompatible polymer does not swell upon immersion in an aqueous solution as discussed supra. In light of this amendment, Applicants respectfully submit that claims 3, 4, 6-22 and 33-47, as amended in the present response and new claims 48 and 49, are not obvious in view of the cited reference as this reference does not teach or suggest each and every element of the invention as presently claimed.

Applicant respectfully submits that Pulfer *et al.* does not teach or suggest a highly cross-linked and extremely hydrophobic polymer which does not swell upon immersion in an aqueous solution, as is claimed in amended independent claims 1, 14 and 33-35. The Pulfer *et al.* reference, in fact, teaches a polymer that swells 70-100% upon immersion in an aqueous solution. Therefore, the cited reference does not teach each and every element in the claims as presently amended and that therefore the pending claims

are inventive over Pulfer *et al.* Accordingly, Applicant respectfully submit that claims 3, 4, 6-22 and 33-47, and new claims 48-49 are not obvious under 35 U.S.C. §103(a) and earnestly request the withdrawal of the outstanding rejection on this basis.

Conclusion

For the foregoing reasons, Applicant believes all the pending claims are in condition for allowance and should be passed to issue. The Commissioner is hereby authorized to charge any additional fees which may be required under 37 C.F.R. 1.17, or credit any overpayment, to Deposit Account No. 01-2525. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned at telephone (707) 543-5021.

Respectfully submitted,

/Alan M. Krubiner, Reg. No. 26,289/
Alan M. Krubiner
Registration No. 26,289
Attorney for Applicant

Medtronic Vascular, Inc.
3576 Unocal Place
Santa Rosa, CA 95403
Facsimile No.: (707) 543-5420